

IV. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1-31 are pending. Claims 1, 12, 14 and 31 have been amended. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicant respectfully requests reconsideration of the rejections of these claims for at least the following reasons.

B. Objections To The Drawings

The Office Action objects to the drawings as follows:

The drawings are objected to because figures 1 and 2 do not show any labels. The figures only show the numbers in the boxes without any label to explain what the boxes mean. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

Office Action, pages 2-3. A similar objection was made in the Office Action dated February 26, 2008; in response, Applicant filed replacement sheets for Figures 1 and 2, that included the requested labels on April 22, 2008. Applicant repeated its request for the entry of these drawings in a Response accompanying a Request for Continued Examination filed June 12, 2008.

Applicant's Representative contacted Examiner Tran to explain this, and Examiner Tran requested that the corrected drawings be re-submitted. Applicant is re-submitting replacement sheets with this paper, and respectfully request that this objection be withdrawn.

C. Claim Rejections under 35 U.S.C. § 101

Claims 1 and 12 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Office Action asserts:

With respect to the rejection of claims 1 and 12, Examiner searched Applicant's specification and did not identify any information that describes the "receiving unit", "first interface unit", "second interface

unit”, and “third interface unit” are configured on hardware. Examiner suggests that Applicant adds the phrase of “a processor,” after “comprising:” and before the “a receiving unit”, and also adds the phrase of “on a hardware” after the phrases of “a receiving unit configured”, “a first interface unit configured”, “a second interface unit configured”, and “a third interface unit configured” (i.e. “a receiving unit configured on a hardware”) to assure the claims meet the requirements. Claim 12 is also required to be amended the same to meet the requirements.

* * *

With respect to the rejection of claims 14 and 31, Applicant has amended the claims in an effort to overcome the rejection. However, Examiner still suggests that Applicant amends the phrase of “a method” in the preamble of claims 14 and 31 to “a computer-implement method” to show that the methods are implemented via a computer.

Office Action, Pages 3-4 (emphasis in original). Although Applicant does not necessarily agree with this rejection, in an effort to expedite the prosecution of the present application, Applicant has amended the claims appropriately.

D. Claim Rejections under 35 U.S.C. § 102(e)

1. Independent Claims 1, 12, 14, and 31

Claims 1-31 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2001/0034676 to Vasic. Specifically, the Office Action alleges that Vasic discloses all elements of the claims. Applicant respectfully disagrees.

In order for a claim to be anticipated by a reference, that reference *must* disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). “The identical

invention must be shown in as complete detail as is contained in the ... claim.”

MPEP 2131 (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Federal Circuit recently reiterated the standard for anticipation under 35 U.S.C. § 102, stating:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net Moneyin v. Verisign, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008). Furthermore, a “reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Sanofi-Synthelabo v. Apotex, Inc.*, 89 USPQ2d 1370, 1375 (Fed. Cir. 2008) (emphasis and alterations in original) (quoting *In re Arkley*, 172 USPQ 524 (CCPA 1972)).

Claim 14 recites:

14. A computer implemented method for offering *financial instruments to pre-qualified consumers*, comprising:

receiving from a database information related to personal identification information associated with a consumer who is a customer of at least one of a financial institution and an entity associated with the financial institution, the consumer personal identification information being *received prior to a consumer contact*;

a programmable processor inquiring a third party based on the received information related to the consumer personal identification information *whether the consumer has been pre-qualified for a financial instrument*, the financial instrument associated with the financial institution, wherein the pre-qualification is based at least in part on a first consumer file;

receiving pre-qualification data from the third party wherein the pre-qualification data relates to a *determination of whether a consumer identifier associated with the consumer is contained in a suppression database*, wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier, *wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file*;

the programmable processor requesting data periodically for requalification of the consumer prior to a consumer contact to reduce a likelihood of offering a financial instrument for which a consumer is no longer qualified; and

the programmable processor offering the consumer the *financial instrument for which he or she is pre-qualified*, if the received pre-qualification data from the third party indicates that the consumer is pre-qualified for a financial instrument,

wherein standards for the consumer pre-qualification are set by the financial institution.

Appl'n, claim 14 (emphasis added).¹ Clearly, claim 14 and other claims are directed to computer implemented systems and methods for offering financial instruments to pre-qualified customers.

Vasic is not directed to such a system or method. Vasic is directed to "a method for accessing payroll," and, in particular, "to a method for allowing employees to receive payroll and access payroll on demand, even in advance." Vasic, ¶ 0003. According to Vasic, it discloses:

a payroll access program providing a means for a third party to receive a request from an employee for payroll access, forwarding the requested funds to the employee on demand, and deducting the forwarded funds from the employee's payroll check. The employee

¹ Independent claims 1, 12, and 31 include similar elements.

may access the money he needs based upon some limit, such as a limit based upon what has already been earned, or based upon probable future earnings for a given pay period.

Id., ¶ 20023. Because it is a payroll access system, and payroll is not a financial instrument, Vasic does not disclose offering financial instruments to pre-qualified consumers. Even in the oft-cited disclosure of Figure 4, Vasic only discloses that “an employee uses a payroll access ATM card to access payroll.” Vasic, ¶ 0071. There is no pre-qualification inquiry with a third party, no review of prequalification data contained in a suppression database, no periodic requalification of the consumer, and no offer of a financial instrument to the pre-qualified consumer.

Moreover, even assuming that the Office Action’s asserting that “the ‘employee’ [of Vasic] is the same as the ‘consumer’ of the Applicant’s invention” is correct, which it is not, the Office Action has not cited anything remotely related to the pre-qualification of the employee for a financial instrument. The payroll access company, the alleged “third party” of the claims, does not provide information regarding any qualification status of an employee. It simply allows employees to access payroll without requiring involvement by the company.

Further, Vasic does not disclose “receiving information related to personal identification information associated with a consumer who is a customer of at least one of a financial institution and an entity associated with the financial institution, *the consumer personal identification information being received prior to a consumer contact*,” recited in independent claim 14. Indeed, Vasic discloses that the employee initiates contact with the payroll access company. *See* Vasic, ¶¶ 0040, 0047-0049. Further, and also cited by the Office Action, Vasic discloses that “the payroll access company … can keep a large master account with funds sufficient to cover payroll access for numerous employees and have separate ‘sub

accounts' for individual employees *that remain inactive and empty until an employee requests access.*" *Id.*, ¶ 0026 (cited by Office Action, page 5). This further illustrates that consumer personal identification information is not received prior to a consumer contact.

The Office Action alleges that Vasic discloses a "suppression database" because the disclosure of "information gathered" is allegedly a "suppression database":

[Vasic teaches] receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database (see Vasic, Figure 4/step 3 "payroll access company gathers information on employees").

Examiner notes that the "information gathered" is the same as the "suppression database" of the Applicant's invention), wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier (see Vasic, par. 26 "secondary payroll access resource such as a sub-account of the master account", Figure 4/step 3 "determines payroll access ATM card limit then forwards the pertinent information to bank"), wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the prequalified financial instruments stored in the first consumer file (see Vasic, Figure 4/step 3 "determines payroll access ATM card limit").

Office Action, Page 6 (emphasis added). Figure 4, step 3 is reproduced below:

PAYROLL ACCESS COMPANY GATHERS INFORMATION ON EMPLOYEES (NAMES, ADDRESS, PHONE, AVERAGE PAYCHECK, TIME ON JOB, SOCIAL SECURITY NUMBER, ETC.) AND DETERMINES PAYROLL ACCESS ATM CARD LIMIT THEN FORWARDS THE PERTINENT INFORMATION TO BANK.

This “information gathered” -- more akin to personal identification information -- cannot be considered to be a “suppression database.” Indeed, the specification of the present application describes a “suppression database,” according to one embodiment, as follows:

In addition, the system or the third party may have a separate “suppression” database that includes information indicative of whether previously qualified consumers have, since prequalification, become unqualified for a financial instrument for any reason. Examples of information that may be maintained in the “suppression” database include the names of consumers who have opted out of sharing information for marketing purposes with credit bureaus or scorers; consumers that have recently responded to other offers of financial instruments by the financial institution; consumers whose credit lines with the financial institution have shifted recently; bankruptcy filings; or lower credit ratings due to increased debt or missed payments. This suppression database may also be checked prior to the offer of the financial instrument to the consumer.

Alternatively to checking the suppression database in real time, the information in the suppression database may be periodically compared in batch operations to the consumer files holding the pre-qualification information, and a consumer’s file or only certain pre-qualified offers in that consumer’s file may be “flagged” to indicate it should be suppressed without altering the stored information in the file. The flag indicates that the consumer should not be offered one or more financial instruments.

Appl'n, Page 21, ll. 4-18 (emphasis added). Applicant has provided this description *twice*, and it is clear that the suppression database identifies previously-qualified consumers that are no longer qualified. None of the information identified in Figure 4 discloses this element.

Further, as noted in the Response filed September 16, 2010, Applicant previously amended the claims to specifically claim the *contents* of the suppression database: "wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file." Nowhere in Vasic is a database including the claimed "second consumer files" -- files that contain *suppression information* -- disclosed. Indeed, there does not appear to be anything of this sort disclosed by Vasic.

For at least these reasons, Applicant respectfully requests that this rejection be withdrawn.

2. Dependent Claims

Although the dependent claims are allowable for at least the same reasons discussed above, Applicants will address several claims individually.²

a. Dependent Claim 15

Claim 15 specifies that "pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer

² To the extent that dependent claims 2-11 include similar elements to dependent claims 15-30, those claims are allowable for at least the same reasons.

with the financial institution.” The Office Action has cited Vasic, paragraph 28, which is reproduced below:

If desired, in one presently preferred embodiment, the amount of funds accessible to the employee may be limited to a predetermined amount. The amount to which the employee is limited may be based, for example, upon a number of factors, such as the amount of the employee's normal paycheck, the relative risk of loss or non-payment, the amount of the transaction fee, the employee's financial history or employment history at the time of the request, the number of days worked for a given pay period and other relevant factors.

Vasic, ¶ 0028. Not only is this not an example of *pre-qualification*, but it is only an example of factors that are considered in determining how much of the employee's payroll should be made accessible to the employee. It has nothing to do with a financial instrument. For this additional reason, Applicant respectfully requests that this rejection be withdrawn.

b. Dependent Claim 16

Claim 16 specifies that “pre-qualification of the consumer occurs prior to receipt of the consumer personal identification information.” As discussed above, Vasic does not disclose pre-qualification. Further, also as discussed above, Vasic discloses that the employee initiates the contact with the payroll access company, and paragraph 26, cited again by the Office Action, is evidence that until an employee initiates contact, no sub-accounts remain empty and inactive. For this additional reason, Applicant respectfully requests that this rejection be withdrawn.

c. Dependent Claims 17 and 18

Claims 17 and 18 specify that “the third party maintains consumer information in files indexed by a unique identifier” and that “the unique identifier relates to the personal identification information of the consumer,” respectively. Although the Office Action cites Figure 4, step 3 as allegedly disclosing a “social

security number" and an "ATM card access code," this element is not disclosed.

For convenience, this step is reproduced below:

↓

PAYROLL ACCESS COMPANY GATHERS
INFORMATION ON EMPLOYEES
(NAMES, ADDRESS, PHONE, AVERAGE
PAYCHECK, TIME ON JOB, SOCIAL
SECURITY NUMBER, ETC.) AND
DETERMINES PAYROLL ACCESS
ATM CARD LIMIT THEN FORWARDS
THE PERTINENT INFORMATION
TO BANK.

↓

This step, which discloses gathering information, does not disclose that the payroll access company maintains the file indexed by a unique identifier. For this additional reason, Applicant respectfully requests that this rejection be withdrawn.

d. Dependent Claim 19

Claim 19 specifies that "the programmable processor offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition." Vasic does not disclose any consumer credit rating; all the Office Action cites is that the website associated with the invention -- the payroll information -- could be used by other parties as proof of income. *See, e.g.,* Vasic, ¶¶ 0066-68. This information is not used by the claimed programmable processor in offering a financial instrument to the employee.

The other paragraphs cited by the Office Action -- paragraphs 28, 53 and 70 -- also do not disclose consumer credit rating. Therefore, for these additional reasons, Applicant respectfully requests that this rejection be withdrawn.

e. Dependent Claims 20-21

Claims 20 and 21 specify that "the financial instrument comprises any financial instrument for which credit information relating to the consumer is

predictive,” and that “the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance.” Clearly, Vasic only discloses access to payroll, not a financial instrument. Therefore, for this additional reason, Applicant respectfully requests that this rejection be withdrawn.

f. Dependent Claim 22

Claim 22 specifies that “the consumer is offered the financial instrument only if one or more pre-determined conditions are met.” As noted above, Vasic does not disclose the offering of financial instruments, and Figure 4, element 3 only discloses the gathering of information. Vasic does not disclose any conditions that are necessary for an employee to access a payroll. Therefore, for these additional reasons, Applicant respectfully requests that this rejection be withdrawn.

g. Dependent Claim 23

Claim 23 specifies that “the consumer personal identification information is obtained when the consumer makes a purchase from a merchant.” Vasic does not disclose any purchases made from a merchant; requesting access to payroll, cited by the Office Action as allegedly disclosing this element, is not a purchase. Therefore, for these additional reasons, Applicant respectfully requests that this rejection be withdrawn.

h. Dependent Claims 24 and 25

Claims 24 and 25 specify that “the consumer personal identification information is obtained through a communication from a business partner of the financial institution or a communication directly to the financial institution” and that “consumer personal identification information is obtained through a telephone call or contact over a computer network.” None of paragraphs 68-70, 72-74, or

Figures 1-3 and 5-7 disclose these elements. Therefore, for these additional reasons, Applicant respectfully requests that this rejection be withdrawn.

i. Dependent Claim 26

Claim 26 specifies that “the programmable processor offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer.” The Office Action cites the disclosure of “short term loans.” in paragraph 5 of Vasic. This paragraph, however, is in the background of the invention and is criticized by Vasic:

Distributing employee pay through a payroll system is a practical necessity for many employers. Typically, employers hire individuals or retain a payroll service to administer the payroll. While the regular periodic disbursement of income through a payroll service or payroll administrator facilitates the payroll process, the timing of employees' need for income does not always coincide with the disbursement of payroll. In this regard, employees must sometimes ask their employers for access to their presently earned (but not yet paid) or future wages in order to meet financial needs which arise before pay day. Making such a request can be awkward and embarrassing. If an employer rejects an employee's request, the employee is faced with unpleasant options. Lacking the necessary finances, the employee may have to suffer some hardship or turn to third party lenders who are unknown to the employee. *Short term loans from third party lenders can take a great deal of time and energy to arrange, can be very expensive, and can expose the employee to potential fraud.*

Vasic, ¶ 0005. Not only does Vasic not offer short term loans, but it is improper for the Office Action to rely on this separate and unrelated disclosure. *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (“The prior art reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without any need for picking, choosing, *and combining various disclosures not directly related to each other by the teachings of the cited reference.*”) (quotations and edits omitted).

Moreover, the Office Action contradicts itself by alleging that “if the consumer does not accept the terms and conditions [of the short term loan], the financial instrument will not be offered.” Office Action, page 10. For terms and conditions to be presented and rejected, however, the short term loan -- which is not offered by Vasic -- must be offered. Regardless, there is no basis for this rejection, and for these additional reasons, Applicant respectfully requests that this rejection be withdrawn.

j. Dependent Claim 27

Claim 27 specifies that “the programmable processor offering the financial instrument to the consumer only if the identity of the consumer is authenticated.” Vasic does not disclose any authentication of the identity of the employee, and Figure 4, step 3’s disclosure of gathering of information does not amount to identity verification. Therefore, for these additional reasons, Applicant respectfully requests that this rejection be withdrawn.

k. Dependent Claims 28-30

Claim 28 specifies that “authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information.” As discussed above, Vasic does not disclose identity authentication, and clearly does not disclose a comparison of stored consumer information to consumer personal identification information. Figure 4, step 3’s disclosure of gathering of information does not amount to identity verification. Therefore, for this additional reason, Applicant respectfully requests that this rejection be withdrawn.

Dependent claim 29 further requires that “the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate

the consumer.” Again, the mere gathering of information in Figure 4, step 3 does not disclose consumer personal information that can be used to authenticate the consumer. Therefore, for this additional reason, Applicant respectfully requests that this rejection be withdrawn.

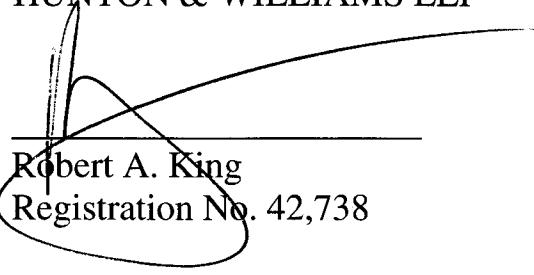
Dependent claim 30 specifies that “authentication is performed by the third party.” As noted above, Vasic does not disclose authentication. Therefore, for this additional reason, Applicant respectfully requests that this rejection be withdrawn.

V. CONCLUSION

Applicant respectfully submits that the application is in condition for allowance. Applicant believes that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned’s Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
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